

II. REMARKS/ARGUMENTS

The above amendments and these Remarks are in response to the Office Action mailed June 13, 2006.

Claims 1-31 were pending in the Application prior to the outstanding non-final Office Action. In the Office Action, the Examiner allowed claims 1-10 and 27-31; objected to claims 17, 18, and 26 as allowable except for depending from a rejected base claim; and rejected claims 11-16 and 19-25.

The present Reply accepts the allowance of claims 1-10 and 27-31; amends claims 17, 18, and 26 by re-writing them as independent claims including all of the limitations of the base claim and any intervening claims; further amends claims 11, 19, and 21; and provides Remarks in response to the rejections concerning claims 11-16 and 19-25. Reconsideration of the rejections respectfully is requested and a Notice of Allowance is requested for the allowed and allowable claims, and any rejected claims that the Examiner allows after reconsideration.

A. Claim Rejections Under 35 U.S.C. § 103(a)

As a preliminary matter, the examiner based his rejection on Fu, U.S. Pat. No. 6,883,792. That patent number does not correspond to a patent issued to Fu, but rather, to Sawada. Applicant believes in good faith that the examiner intended to reference Fu, U.S. Pat. No. 6,882,793, and has rendered the following Remarks and Arguments based upon such good faith belief. However, in the event that Applicant's understanding is incorrect, Applicant requests that the examiner telephone Applicant's patent counsel with regard to this matter, so that Applicant can submit other Remarks.

Claims 11-16 and 19-25 were rejected under 35 U.S.C. §103(a) as being unpatentable over Fu *et al.* (U.S. Patent 6,882,793; hereafter, "Fu"). Applicant respectfully disagrees because Fu neither teaches nor suggests each and every limitation of independent claims 11, 19, or 21, as amended.

Independent claim 11 has been amended to include one of the limitations set forth in the examiner's Statement of Reasons for Allowance, Office Action at 5, stated by the examiner to render patentable the subject matter of claims 1-10. Specifically, independent claim 11 as amended now teaches:

11. (Currently amended) A video collage, comprising:
a video collage template having at least one individual video frame; and,
a representative image associated with a video segment, wherein said representative image is contained in said at least one individual video frame, and wherein the video segment is one of a plurality of video segments based upon global properties of the entirety of a video.

Accordingly, independent claim 11 is not obvious over the cited art and is patentable.

Dependent claims 12-16 which depend directly or indirectly from claim 11 also are patentable over the cited art for depending from patentable subject matter. Reconsideration of the rejection respectfully is requested, as well as a Notice of Allowance for claims 11-16.

The examiner suggested that independent claim 19 is rejected for grounds similar to the those suggested for independent claim 11. Office Action at 4. Applicant respectfully disagrees but has amended claim 19 with a similar limitation as amended claim 1, wherein such limitation is adapted from the examiner's Statement for Reasons of Allowance. Office Action at 5. Independent claim 19 as amended is reproduced below for the examiner's convenience:

19. (Currently amended): A video collage user interface, comprising:
a video collage template having at least one individual video frame;
a video segment template including a plurality of representative images, wherein each representative image is associated with a video segment; and,
a video segment selection device, wherein a plurality of video segments are selected based upon global properties of the entirety of a video.

With regard to independent claim 19, the examiner suggests that claim 19 is analyzed and rejected based on similar grounds as claim 1. Office Action at 5. Applicants respectfully disagree, and refer the examiner to claim 19 as amended and to the above remarks in connection with the rejection of claim 1, and incorporate said remarks herein in full, by reference. Accordingly, Applicants respectfully request reconsideration of the rejection of independent claim 19 as amended.

Because independent claim 19 as amended is allowable over the cited art, claim 20 which depends from claim 19 also is allowable. Reconsideration of the rejection respectfully is requested.

With regard to independent claim 21, the examiner rejected claim 21 as similarly analyzed as claim 11. Applicant disagrees and has amended independent claim 21 in a way similar to claim 11, to overcome the rejection. Accordingly, claim 21 is allowable over the cited art, and reconsideration of the rejection respectfully is requested. Further, claims 22-25 which depend directly or indirectly from claim 21 also are patentable.

With regard to dependent claim 24, claim 24 depends from claim 21, which has been amended to include a limitation cited by the examiner as constituting a reason for allowance. Therefore, claim 21 is patentable over the cited art.

Further in regard to claim 24, although the above remarks render the claim patentable over the cited art, it should be noted that the examiner has improperly cited the Chiu reference against Applicants. The rejection is based upon Fu in further view of Chiu *et al.* (U.S. Pat. No. 6,819,795; "Chiu"). The Chiu reference cannot be cited against the present application, pursuant to section 103(c), which provides:

Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

35 U.S.C. Section 103(c) as amended, effective November 29, 1999. Thus a safe harbor exists that exempts art that has developed within an organization that falls under section 102(e). Therefore, the examiner may not base a rejection on section 102(e) if the subject matter in the art and the claims of the application under review were commonly owned at the time the invention was made.

Here, Chiu was filed on July 7, 2000, and it was not published because the pre-issue publication rules apply to patent applications filed on or after November 29, 2000. The first publication of Chiu was after issuance on November 16, 2004. The current application was filed on November 16, 2001. Therefore Chiu cannot be 102(a) or (b) prior art against the current application. Therefore, the examiner must have cited Chiu as a potential 102(e) reference, even though it does not teach each limitation of claim 24 of the present application.

Because Chiu must be a section 102(e) reference, the safe harbor of section 103(c) applies where Chiu and the claimed invention (here, claim 24 of the present application) were "owned by the same person or subject to an obligation of assignment to the same person." In fact, both Chiu and the present application were subject to an obligation of assignment to Fuji Xerox Co., Ltd. at the time the present application was filed on November 16, 2001. Both Chiu and the present application currently are assigned to Fuji Xerox Co., Ltd. Accordingly, Chiu cannot be cited against the present application in a section 103(a) rejection, because the safe harbor applies from section 103(c). Pursuant to 37 C.F.R. section 1.130, a proper terminal disclaimer pursuant to 37 C.F.R. section 1.321(c) is attached hereto in Appendix A, together with a declaration stating that "the application . . . and the patent . . . are currently owned by the same party, and that the inventor named in the application . . . is the prior inventor under 35 U.S.C. 104."

III. Claims to Which the Examiner Objected

The examiner objected to claims 17, 18, and 26 as being dependent upon a rejected base claim, but were stated to be allowable if rewritten in independent form.

Applicant has amended claims 17, 18, and 26 to make them into independent claims that include the limitations of their base claims, and the intervening claims. The amended claims are patentable and accordingly, a Notice of Allowance respectfully is requested.

IV. Conclusion

In light of the above, it is respectfully submitted that all remaining claims, as amended in the subject patent application, should be allowable, and a Notice of Allowance is requested. The Examiner is respectfully requested to telephone the undersigned if she can assist in any way in expediting issuance of the patent.

The Commissioner is authorized to charge any underpayment or credit any overpayment to Deposit Account No. 06-1325 for any matter in connection with this response, including any fee for extension of time, which may be required.

Respectfully submitted,

Dated: September 11, 2006

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